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No. 82-690

In the Supreme Court of the United States

OCTOBER TERM, 1982

GENERAL MOTORS CORPORATION,
Petitioner,

vs.

INTERNATIONAL TRADE COMMISSION
AND KUHLMAN CORPORATION,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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QUESTION PRESENTED FOR REVIEW

Did the Court of Customs and Patent Appeals erroneously validate patent 3,782,708 when it treated the presumption of validity and "secondary" tests of invention as controlling rather than substantially considering what the inventor claimed to have originally discovered and focussing on what claimed acts could qualify as an exercise of the inventive faculty?

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[1] Respondents on this petition are the United States International Trade Commission and Kuhlman Corporation, a corporation of the State of Michigan. Respondents below, who did not appeal to the Court of Customs and Patent Appeals, are P.J. Wallbank Manufacturing Co. Ltd. incorporated under the laws of the Province of Ontario, Canada, and Ford Motor Company, a corporation of the state of Delaware. The sole petitioner here is General Motors Corporation, a corporation of Delaware.

GM's Rule 28.1 listing is Appendix p. 89a, below.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioner, General Motors Corporation, respectfully prays that a writ of certiorari issue to review the judgment entered on September 3, 1982 by the United States Court of Customs and Patent Appeals.

OPINIONS BELOW

The opinion of the Court of Customs and Patent Appeals is not yet reported. It appears at appendix page 1a. The opinions of the International Trade Commission and the Administrative Law Judge are likewise not reported. They appear at appendix pages 22a and 49a, respectively.

JURISDICTION

The opinion and judgment of the Court of Customs and Patent Appeals herein was rendered on September 3, 1982. By order dated September 24, 1982 that court stayed its mandate to and including October 24, 1982. By Sections 402 and 403(b) of the Act of April 2, 1982, Public Law 97-164, 97th Congress, 96 Stat. 57-8, matters pending before the Court of Customs and Patent Appeals on October 1, 1982, were transferred to the United States Court of Appeals for the Federal Circuit.

This petition is filed within 90 days of the opinion and judgment of the Court of Customs and Patent Appeals herein. Until October 1, 1982, this Court had jurisdiction to review the judgment by writ of certiorari to the Court of Customs and Patent Appeals under 28 USC 1256 and 28 USC 2101(c). Thereafter, this Court has had jurisdiction under 28 USC 1254 and 28 USC 2101(c) to review the judgment by writ of certiorari to the United States Court of Appeals for the Federal Circuit, to which the case has been transferred.

STATUTES INVOLVED

This petition involves Title 35, United States Code, which in its pertinent portions provides —

§101. Inventions patentable

Whoever invents or discovers any new and useful * * * manufacture, * * * may obtain a patent therefor, subject to the conditions and requirements of this title.

§102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless —

* * *

(f) he did not himself invent the subject matter sought to be patented, or

• • •

§103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§282. Presumption of validity; defenses

A patent shall be presumed valid. • • •. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it.

STATEMENT OF THE CASE

Introduction

This case arose on a complaint by the International Trade Commission under Section 337 of the Tariff Act of 1930, as amended. Respondent Kuhlman (complainant below) sought to exclude from importation certain spring/seat assemblies used in lieu of separate springs and seats in automatic transmissions. The assemblies were alleged to infringe Dulude and Winbigler product patent 3,782,708 and to have been made within the scope of their process patent 3,866,287. The accused assemblies were made in Canada by respondent Wallbank. General Motors and Ford were added by the Commission as additional respondents below.

The sole issue here is whether the court below properly validated the '708 product patent.

1. The '708 Product Patent and the Dooley Disclosure

The Dulude et al '708 product patent describes and claims an assembly comprising a sheet metal stamping 26 (yellow) having an annular base portion 24 to which a plurality of compression coil springs 22 (blue) are attached in the format of patent Figure 2. In the preferred form of the alleged invention, each spring is affixed by staking its end turn against the sheet metal seat as shown in patent Figure 3.

The alleged invention evolved from a meeting in February 1971 at the GM Parma, Ohio, transmission plant between

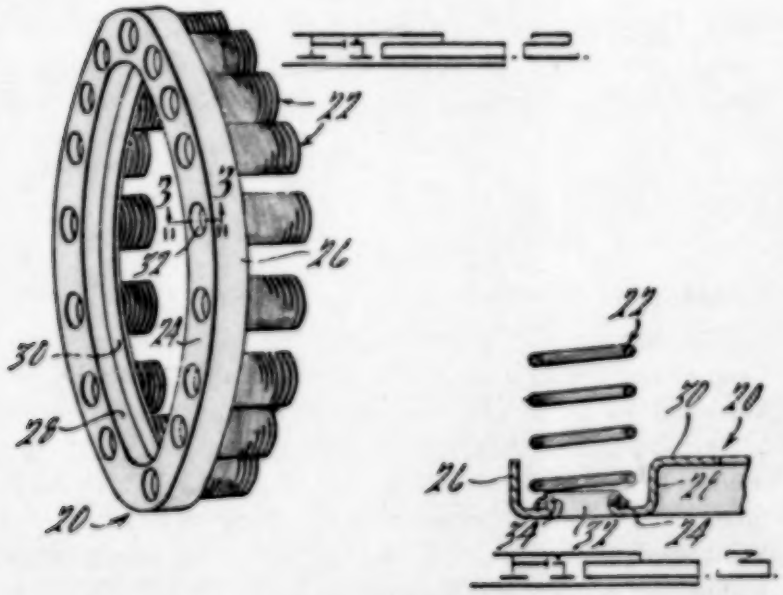


Chart 1
The '708 Patent,
Figures 2 and 3

one Dooley, a GM buyer, and the co-patentee Dulude. At that time, Dooley described the format of the spring/seat assembly to Dulude and showed him a model made by Kruse of GM in which the springs were attached in the required format by epoxy cement. The alleged invention of the '708 product patent results from Dulude's use of staking rather than epoxy cement to attach the springs.

At the time of the Dooley disclosure, automatic transmissions were assembled at Parma by first making a loose preassembly of the bell, helical compression springs, and sheet metal spring seat. The 17 helical springs (blue) were respectively telescoped over the 17 then-upstanding bosses 18 of the vertically oriented die cast bell 10 (pink). The sheet metal seat or "annular plate" 14 (yellow) was then laid over the upstanding free and unconstrained ends of the springs. The assembly, with the parts still unattached, was conveyed to the transmission assembly point. In the completed transmission, the springs were trapped in place and thereby secured so that no attachment to other parts was required.

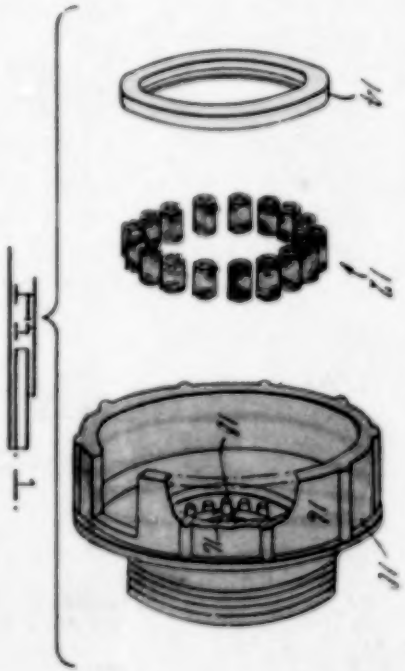


Chart 2
The '708 Patent,
Figure 1

The patent describes this transmission assembly technique and its deficiencies. It does not reveal, and the Patent Office was not informed, that both the fact of these disadvantages and the structure required to overcome them, were previously described by Dooley to Dulude and were not original inventions of the patentees, Dulude and Winbigler. 58a

The required structure, as described by Dooley to Dulude, is depicted in annexed Chart 3. The seat (yellow) and the springs (blue) used in the prior assembly practice were to be attached to each other in the same positions they were loosely placed in making the prior unconnected assembly. The preattached springs would thus form the same subassembly with the same bell (10, Chart 2) as was then in use. To do this, the springs needed to be spaced circumferentially about the seat and project in substantial parallism from the seat so that the free ends of the springs would telescope over their respective bosses 18 as before (Chart 2).

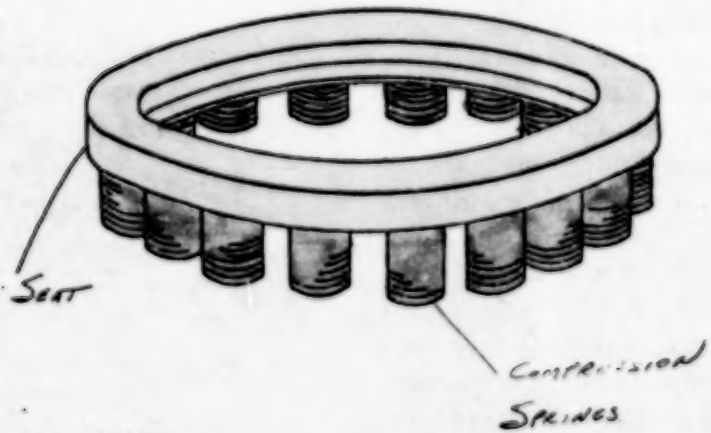


Chart 3
The Dooley-Disclosed Format

At the Dooley conference, Dulude asked "Why couldn't we try to stake these on?". While returning to his plant, Dulude sketched the springs he saw and the staking attachment he envisioned. (Chart 4)

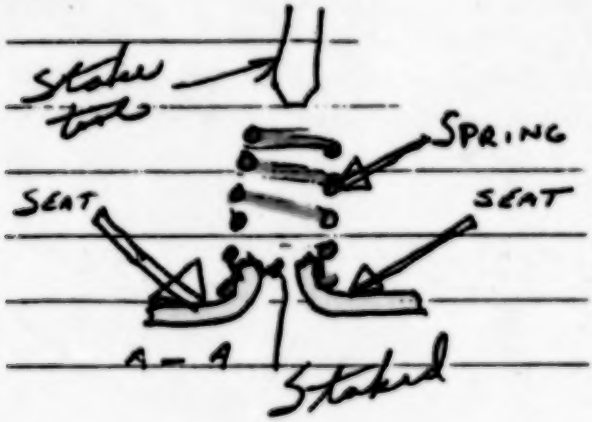


Chart 4
Dulude's Concept Sketch*

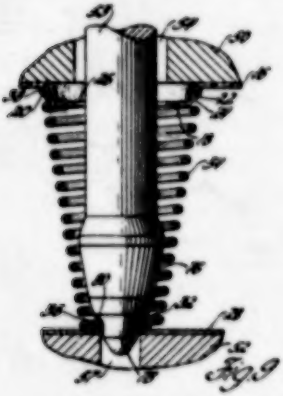
2. The Prior Art

Dulude and Winbigler were not the first to attach springs to sheet metal by staking, either generally or in substantially the same way as is shown in the Dulude et al patent.

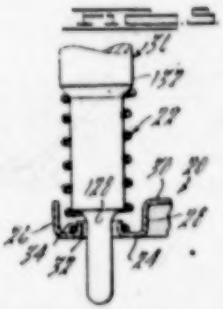
Prior art Schaad patent 3,122,829, shows seat cushion springs (blue) with the end turn of each staked to a sheet metal seat (yellow) by upstanding open cylindrical protuberances substantially as in Dulude's sketch and as described in the patent here in suit. Chart 5. In Schaad, as in the '708 patent, the sheet metal is first deformed to make the upstanding cylindrical protuberances to receive the springs. Each spring is then telescoped over its protuberance with its end turn against the seat. A staking punch is then pushed down through the spring and the protuberance to expand the protuberance from

* from Kuhlman Exhibit 132

the inside out, forcing the metal against the inner face of the end turn to stake, crimp, or capture the end turn and therefore the spring. 66a. In Schaad, as in the patent, the staking metal grips 360°, or less, of the end turn surrounding the protuberance. id.



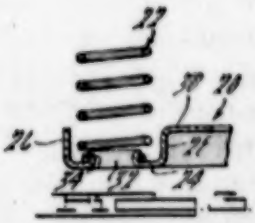
Schaad Prior Art



Patent in Suit

During Staking

Schaad Prior Art



Patent in Suit

After Staking

Chart 5
Schaad Prior Art '829 Patent vs. '708 Patent

The Schaad patent is entitled "Method of Assembling a Coil Spring Seat Cushion". Hence Schaad's usage of conical seat cushion springs having lower end coils with flat spiral portions immediately outboard the approximately 360° staked portion and a cushion over the otherwise free ends of the springs. 66a. The product required by Dooley used the helical production transmission springs Dulude saw on the Kruse model and showed in his own sketch (Chart 4). The required attachment was in the format of the Kruse epoxy model shown to Dulude, that is with the springs set in a circle around the annular seat or base straight and parallel without being constrained at the top or above the first turn. 76a. Making such required product using staking in lieu of epoxy cement and in accordance with Dooley's requirements precluded usage of Schaad's seat cushion type springs and the cushion over the free ends of the springs.

As Chart 5 shows, the gripping relationship between the seat and the spring turn engaged by the staking metal is the same in Schaad as in the '708 patent.

Contrary to the court below (10a-11a), the Delco-Moraine prior art was not before the Patent Examiner. It, like Dulude et al, uses a helical spring with no flat spiral portion. 12a.

3. The Claim to Discovery and the Patent Examiner's Unpatentability Ruling.

Kuhlman does not argue that Dulude's idea that he would try to stake the springs to the seat was the invention. 73a. The Administrative Law Judge found that it would have been obvious to try to stake. 77a. The contention is that the specific manner in which the springs were secured to the base made a small but new contribution to the art. 73a.

The left hand column of annexed Chart 6 sets forth the text of base claim 1 of the patent application just before insertion of the final claim limitation, highlighted in yellow on the right

A spring assembly comprising	A spring assembly comprising
a sheet metal stamping including an annular base portion and a plurality of protuberances formed integrally on said base portion and circumferentially spaced around said annular base portion and projecting in one direction therefrom, and	a sheet metal stamping including an annular base portion and a plurality of protuberances formed integrally on said base portion and circumferentially spaced around said annular base portion and projecting in one direction therefrom, and
a plurality of compression coil springs individually having a portion of one turn secured by each of said protuberances to said annular base portion,	a plurality of compression coil springs individually having a portion of one turn secured by each of said protuberances to said annular base portion,
	said one turn being unground and of uniform cross-sectional material,
all other turns of each of said springs being spaced from said base portion,	all other turns of each of said springs being spaced from said base portion,
all portions of said springs other than said one turn lying in their free unconstrained positions,	all portions of said springs other than said one turn lying in their free unconstrained positions.
said springs projecting in substantial parallelism with one another from said base portion in said one direction.	said springs projecting in substantial parallelism with one another from said base portion in said one direction.
Rejected Application Claim 1	'708 Patent Claim 1

Chart 6 — Dulude et al Base Claim 1
Before and After Final Amendment

hand column. The pink limitations relied upon by the court below in differentiating Schaad had previously been inserted in the claims and are the same in the rejected application claim as in the patent claim. The Patent Examiner rejected the claim as proposed because the prior art, including Schaad, showed it was "obvious to have just the bottom coil to be mounted". Accepting rather than appealing the rejection, Dulude et al amended the claim by adding the further limitation. They stated to the Patent Examiner that "By virtue of . . . the addition of the noted limitation, it is believed that the claim clearly distinguishes from the fair teachings of the relied-upon prior art, alone or in any fair combination". The Patent Examiner then allowed the claims. 88a.

The amendment leading to claim allowance required that "said one turn be(ing) unground and of uniform cross-sectional material".[2] The Administrative Law Judge found that "Schaad's lower turn, however, was in fact unground, and this would not have been a valid distinction." 74a, 69a. This finding was approved on review. 37a.

4. "Secondary Evidence"

Dooley kept the Kruse epoxy model on his desk and showed it to various suppliers. 58a. None responded with proposed constructions of their own. Id. There is no substantial evidence that any of them actually tried to make a spring/seat construction having the format of the model. Prior to the Dooley-Dulude conference, Kruse had suggested "making projections on retainer which capture spring" 57a. GM considered attaching the springs on cylindrical protuberances on

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[2] A "ground" helical spring has its bottom turn ground off in a plane normal to the axis of the spring, so that the spring stands upright on a flat surface more easily. The end turn then tapers down from the circular wire cross section in progressively increased flatness to a point, making it of non-uniform cross-sectional material. The terminal five words of the inserted limitation are therefore redundant.

the seat, and had identified problems to be overcome with this technique. id. GM never devoted much effort on this proposal and only a small amount of effort to the problem of attaching the springs. Id. and 76a. There was no GM activity after March 1971, when Dulude delivered hand made models to Dooley. 60a.

In the hand made models the springs tilted too much to fit on the nubs of the bell or piston. 80a. Winbigler spent many months devising a production machine and process to achieve non-tilted springs without hand straightening. 80a-83a. After many tries, he finally achieved a machine and staking tool which made the springs lean "predictably", that is a uniform amount and direction in relation to the cutoff end of each spring. 80a. Once this observation was made, the spring coiler man was instructed to adjust the spring coiling machine to compensate for that predictable lean. Id. The process of making the assemblies using the machine and staking tool giving the predictable lean is covered by the '287 Dulude and Winbigler process patent, which has been held valid and of scope covering the Wallbank method of manufacture.

Spring/seat assemblies made under the product and process patents, and using the spring coiler adjustment, were placed in production in late 1971. They enjoyed progressively increased usage thereafter.[3] The expensive cast bosses or nubs

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[3] The CCPA opinion, footnote 12, states that "GM does not challenge the weight which the Commission gave to the evidence" of commercial success, prior failures by others, and the like. 16a. The GM brief stated that "the evidence was shaky, far from compelling, and the ALJ made findings contrary to Kuhlman's exaggerated position. The Commission wisely gave the events the matter-of-fact treatment they deserve". GM also argued that "Where, as here, obviousness of the claims over the prior art is clearly present, no amount of commercial success, prior failures, etc., can tip the scales in favor of patentability or rewrite the

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on the bell were removed to achieve cost savings, as the court below noted. 13a. This change followed Dooley's suggestion to Dulude and was not a conception by Dulude or Winbigler. There is no substantial evidence indicating whether the success was due to the product, usage of the processes of the '287 patent (which has been held valid and infringed), or to the adjustment of the spring coiler, which is not described in either patent.

5. The Rulings Below

The Administrative Law Judge held certain claims of the '287 process patent valid and of scope covering Wallbank manufacturing processes. Noting this Court's ruling in *Anderson's Black Rock* v. *Pavement Salvage Co.*, 396 U.S. 57 (1967), and that no synergistic effect was being claimed, she held that the '708 product patent claims failed to meet the unobviousness requirement of 35 USC 103. 77a. She also held that the claims failed to meet the requirement of 35 USC 112 that the invention be particularly claimed. 79a. The ALJ carefully considered the "secondary considerations" relied upon for patentability but concluded that such could not overcome claims "too broad to be valid". id.

The ALJ took Dulude's derivation from Dooley into account by finding that the only claimed matter not in the prior art was the format, and that this could not be the only inventive contribution by Dulude et al since Dooley had disclosed this to Dulude. 77a.

The ALJ credited Dulude et al with the inventive step of securely attaching a set of helical springs to the base by staking

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claims", citing *Calmar* v. *Cook Chemical*, 383 U.S. 1, 35 (1966); *Sakraida* v. *Ag Pro*, 425 U.S. 273, 282 (1976) and *Anderson's Black Rock, Inc.* v. *Pavement Salvage*, 396 U.S. 57, 60 (1969).

the small amount of metal available with the particular springs and seat required by Dooley. 74a, 60a. The claims nowhere refer to the amount of metal, and are not limited to such invention. 88a.

The Commission Investigative Counsel reached a like determination on the product patent invalidity, which he considered to claim only "good engineering practice" in the light of the prior art and the Dooley disclosure.

The International Trade Commission reversed the ALJ and held the '708 product patent valid. It relied on a strong presumption of patent validity under 35 USC 282, and "clear indications of nonobviousness". 46a. The latter determination was based in part on the Commission observation that it was reasonable to expect that "if the problem were easy to solve, or if the solution were obvious, it would have been solved promptly and without difficulty by GM or one of the other, larger spring suppliers". 42a. The Commission did not limit the Dulude et al invention to the small amount of metal found by the ALJ to be the only invention made.

The Commission dismissed the Kruse model shown to Dulude as a "nonfunctional, concept model", representing unfulfilled desires. 34a. It recognized that the Kruse model "showed the parts that needed to be assembled", that is the helical transmission springs and the sheet metal seat. 25a, 34a. The Commission did not discuss how these specific helical springs and seats could be secured together by the staking technique of the Schaad prior art patent without necessarily obtaining the Dulude construction. It did not consider what, if any, specific acts of Dulude et al could be exercise of the inventive faculty, and did not refer to the ALJ's finding that it would have been obvious to try to stake the springs to the seat. 77a.

The Court of Customs and Patent Appeals affirmed the ITC, but applied a third approach. It articulated and relied

upon two differences between the Schaad prior art patent and the patent in suit. These were (a) the additional ½ "dead" turn in Schaad due to the flat spiral portion of the seat cushion springs he used and (b) Schaad's seat cushion cover over the free ends of the springs. 11a-12a. These differences, the absence of evidence that either GM or the other suppliers had made similar structures, commercial success, and the presumption of patent validity under 35 USC 282, prompted affirmance of the ITC.

The Commission and the ALJ concluded that the Dooley disclosure was not "prior art" to be combined with other prior art in determining compliance with 35 USC 103. 35a, 64a. The CCPA apparently held that the status of the Dooley disclosure as "prior art" is immaterial. 14a.

The court did not discuss the ruling of the Patent Examiner that the claims were not allowable over the Schaad patent and other prior art, although this was argued in the briefs. The court labeled as "incongruous" GM's endorsement of the reliance of the ALJ on "synergism", that is this Court's opinion in *Anderson's Black Rock* v. *Pavement Salvage Co.* 396 U.S. 57 (1969). 15a. The court dismissed the Dooley disclosure as conveying only "the way the thing should look", without noting that the Kruse model also showed the parts that needed to be assembled. 14a.

REASONS FOR GRANTING THE WRIT

-I-

The Error Below Requires Prompt Correction

The Court of Customs and Patent Appeals was first assigned jurisdiction to consider validity of issued patents by Section 341 of the Trade Act of 1974, 88 Stat. 2054. It has responded in a series of decisions which render the presumption of patent validity under 35 USC 282 controlling in

most every case. In *Stevenson* v. *ITC*, 612 F(2d) 546,551-4 (1979), for example, the court relied upon the presumption even though the most pertinent prior art item had not been revealed to the patent examiner. And see: *Astra-Sjuco* v. *ITC*, 629 F(2d) 682, 688 (1980); and *Solder Removal* v. *ITC*, 582 F(2d) 628,632 (1978) (dictum). In the present case the court has elevated "secondary" evidence of invention and the presumption to controlling significance in validating the patent, without substantial inquiry on whether there was exercise of the inventive faculty and without considering the Patent Examiner's ruling of unpatentability over the prior art. This is in clear contradiction to the rulings of this Court as we show in part II below.

The Act of April 2, 1982, 96 Stat 25, has now merged the Court of Customs and Patent Appeals and the Court of Claims to form a single court with exclusive jurisdiction not only of appeals from the International Trade Commission but also appeals in all other cases involving issued patents. 28 USC 1295, as amended April 2, 1982, 96 Stat 37. Until this statute, the regional courts of appeal in patent infringement actions under 35 USC 1338 and 35 USC 1291 have exercised final control on patent validity. Thus, in *Stevenson* v. *Grentec*, 652 F(2d) 20 (1981) (cert. den. April 27, 1982, 81-1185) the Court of Appeals for the Ninth Circuit held invalid the same patent that the CCPA had validated in *Stevenson* v. *ITC*, supra. Directly contrary to the CCPA, the Ninth Circuit held that the presumption of patent validity was dissipated by the fact that the prior art item had not been revealed to the Patent Examiner. Id. at 21. Also, the CCPA considered prior art disclosures as only "prima facie justification" for holding obviousness and the "secondary considerations" must always be considered. *Stevenson* v. *ITC*, supra, at 552. Directly contrary to the CCPA, the Ninth Circuit held that commercial success and other "secondary factors" cannot save an otherwise obvious patent from invalidity. *Stevenson* v. *Grentec*, supra, at 23.

Following the Ninth Circuit decision, the ITC subsequently dissolved and withdrew its exclusion order. The new statute terminates this protection against error and leaves this Court as the only tribunal that can act.

The decision below was by four members of the CCPA and the chief judge of the Court of Claims, which is combined with the CCPA to form the new court. The fifth member of the CCPA, Judge Rich, sat on *Stevenson* v. *ITC*, supra, and *Astra-Sjuco* v. *ITC*, supra, where the court has similarly inflated the role of the presumption. Half of the active members of the new court, including the two prior chief judges, are thus personally committed to the erroneous view of the presumption of validity followed in this case. This case will clearly be a precedent in future cases in the new court, to which it is already transferred under Sections 402 and 403(b) of Public Law 97-164, supra.

Tension has long existed between those who would sustain patents by emphasizing the presumption of validity and concentrating on commercial success, and those who would focus on the patentee's claimed acts and require an exercise of the inventive faculty. This Court has always concentrated on what the inventor claims to have done. The conflict between the CCPA in *Stevenson v. ITC,* supra, and the Ninth Circuit in *Stevenson v. Grentec,* supra, clearly reveals both the practical significance of the difference and the divergence between the CCPA and the regional courts of appeal. The 1982 Act is only intended to "promote certainty where it is lacking to a significant degree" by concentrating all patent appeals in a single court. House Report No. 97-312, Nov. 4, 1981, to accompany H.R. 4482, p. 22. If allowed to stand, the decision below will be a first step in expanding that narrow purpose to a *de facto* change in the substantive patent law. By granting the writ, and ending this error before it infects further decisions, this Court can confine the 1982 Act to its intended effect.

-II-

The Decision Below Is Contrary To The Settled Law of This Court

This Court has consistently and firmly required exercise of the inventive faculty before a patent may be obtained. *Dann* v. *Johnston*, 425 U.S. 219, 225 (1976). 35 USC 101 permits patenting only by one who "invents or discovers"; 35 USC 102(f) precludes patenting what the alleged inventor "did not himself invent"; and 35 USC 103 precludes a patent if it differs over matter in Section 102 but nevertheless would have been obvious. As the ALJ found, it would have been obvious to try staking the springs rather than gluing. 77a. Usage of the springs and seats of the Kruse model, and attachment in the format of the Kruse model — all in accordance with Dooley's disclosure — compelled the differences from the Schaad prior art patent relied upon by the court below. Neither the ITC nor the court below significantly addressed this matter.

Further, in *Graham* v. *John Deere*, 383 U.S. 1, 16-19 (1966), this Court held that the 1952 Patent Code did not change the strict standards by which patent validity is to be determined. This Court applied these strict standards to invalidate the patent before it in *Anderson's-Black Rock* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969), and *Sakraida* v. *Ag Pro Inc.*, 425 U.S. 273 (1976). Each of these cases, as did *Graham* v. *John Deere*, supra, involved a new combination of elements which were individually old in the art. This case, too, involves elements individually old in the art, combined in the format previously disclosed by Dooley to Dulude and therefore not Dulude et al's invention. 77a, 41a. In *Anderson's-Black Rock*, this Court relied upon *A and P Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147, 153 (1950), to require that the combination of individually old mechanical elements achieve a synergistic result, that is an effect greater than the sum of the several effects taken separately. In *Sakraida* v. *Ag Pro*, 425 U.S. 273, 282 (1976), this Court

again required a synergistic result, or effect greater than the sum of the effects of the old elements taken separately, and again emphasized that courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assemblage of old elements.

This Court's rulings requiring "synergism" are not to be discarded as "incongruous" as occurred below. 15a. And the rulings surely are not to be set aside by elevating the presumption of patent validity and "secondary" tests to controlling significance where there is no showing and no attempt to show that synergism is present.

In applying the strict standard of obviousness, and in determining whether the inventive faculty has been exercised, the Patent Office history must always be taken into account. *Calmar* v. *Cook Chemical*, 383 U.S. 1, 33-4 (1966). Here, as in *Calmar*, the patent was obtained only by accepting the limitations imposed by the Examiner. Also, as in *Calmar*, it is impossible to explain the Examiner's allowance of the '708 patent upon the basis of the final amendment which the ALJ found to be an "invalid" distinction. 74a, 69a. The claim containing all the language relied upon by the court below was held invalid — not valid — by the Patent Examiner, even though he was not informed of either the Dooley disclosure or the Delco-Moraine prior art. The only rational conclusion from the action of the Patent Examiner is that presumption was dissipated and the claims are invalid — not the converse as applied by the court below.

It is equally well settled that secondary considerations such as long felt want, commercial success, failure of others, etc. at most only give light to the circumstances surrounding the origin of the subject matter sought to be patented. *Graham* v. *John Deere Co.*, supra. at 17-18. Here there is no record evidence disentangling the product, the process, and the

spring coiler adjustment as reasons for such success as did occur or the lack of a like response by others to the Kruse model. And the findings are that even GM did not try very hard. 58a, 76a. It is also settled that secondary considerations can only dispel doubt on the issue of validity and cannot be relied upon where unpatentability is otherwise clearly present. *Calmar* v. *Cook Chemical*, supra at 35-6.

If the decision below stands, the test of patentability will revert to the discredited dissenting opinion in *Hotchkiss* v. *Greenwood*, 11 How. (52 U.S.) 248 at 267 (1850). That dissent would have made patentable any product that was "better and cheaper" than what came before. The court below has applied the same test by its virtually conclusive presumption of patent validity where there is "secondary evidence", such as "better and cheaper". In *Hotchkiss* v. *Greenwood* the majority of this Court rejected this lenient standard. That majority view was the unanimous construction of 35 USC 103 by this Court in *Graham* v. *John Deere*, supra at 16-19. The majority opinion in *Hotchkiss* v. *Greenwood* was again referred to and relied upon by this Court in *Sakraida* v. *Ag Pro*, supra, at 282.

CONCLUSION

The petition should be granted.

Respectfully submitted,

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